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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,485	03/09/2004	Vahid Saadat	USGINZ00130	3298
40518 7590 10/15/2008 LEVINE BAGADE HAN LLP 2483 EAST BAYSHORE ROAD, SUITE 100 PALO ALTO, CA 94303				
EXAMINER				
KASZTEJNA, MATTHEW JOHN				
ART UNIT		PAPER NUMBER		
3730				
MAIL DATE		DELIVERY MODE		
10/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,485

Applicant(s)

SAADAT ET AL.

Examiner

MATTHEW J. KASZTEJNA

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-71, 73-80, 82-84, 92 and 94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-71, 73-80, 82-84, 92 and 94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 67-71, 73-80, 82-84, 92 and 94 in the reply filed on June 30, 2008 is acknowledged.

Notice of Amendment

In response to the amendment filed on June 30, 2008, canceled claims 85, 87-91 and 93 are acknowledged. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 67-71, 73-80, 82-83, 92 and 94 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,916,147 to Boury.

In regards to claims 67 and 92, Boury discloses an endoluminal apparatus 10 comprising: an elongated main body 30 having a proximal end 20, a distal end 16 and at least one lumen 142 extending through the main body the main body having at least a first section 36a near the proximal end and a second section 36d near the distal end, and with the first section comprising a plurality of nested links 140 with substantially all adjacent links having mating surfaces that are in contact with but that are not connected to each other (see Fig. 7 and Col. 13, Lines 43-67), wherein the first section may be selectively switched between a substantially flexible condition and a substantially rigid

condition (see Col. 6, Lines 8-19) wherein the second section is steerable relative to the first section (see Fig. 2 and Col.7, Lines 47-56); and a scope being movable through the lumen relative to the elongated main body (see Col. 2, Lines 30-43). Specifically, **in regard to claim 80 and 83**, an endoscope being passed through the lumen of the apparatus, Boury incorporates the teachings of U.S. Patent No. 5,325,845 to Adair which teach of a steerable sheath 12 through which an optical catheter 18 is passed.

In regards to claim 68, Boury discloses an endoluminal apparatus, wherein the main body includes a torque transmitting feature which provides torque transmission between the proximal and distal ends while the main body is unlocked, to cause the main body to rotate substantially about its central axis (see Figs. 1b-2 and Col. 4, Lines 51-60).

In regards to claim 69, Boury discloses an endoluminal apparatus, comprises an atraumatic tip 16 having at least one opening corresponding to the at least one lumen (see Col. 4, Lines 4-5).

In regards to claim 70, Boury discloses an endoluminal apparatus, wherein the second section may be switched between a flexible state and a substantially rigid state independently of the first section (see Figs. 1-2 and Col. 5, Lines, 40-65).

In regards to claim 71, Boury discloses an endoluminal apparatus, with substantially each link in the first section configured to allow partial rotation relative to adjacent links and with the links arranged so that the first section can bend in at least two dimensions (see Fig. 1b and Col. 6, Lines 34-47).

In regards to claims 73-74, Boury discloses an endoluminal apparatus, wherein the second section is steerable in up to three dimensions relative to the first section (see Col. 7, Lines 47-52 and Col. 8, Lines 40-41).

In regards to claim 75, Boury discloses an endoluminal apparatus, further comprising at least one tensioning element 34a-d routed through the elongated main body (see Fig. 7), wherein compression of the plurality of adjacent links by a tensioning element places at least the first section, or second section or both sections into the substantially rigid condition (see Fig. 2 and CO. 8, Lines 13-26).

In regards to claims 76-79, Boury discloses an endoluminal apparatus, further comprising at least two liners 80 extending along a length of the elongated main body (see Fig. 7 and Col. 12, Lines 25-59). Boury teaches that both an inner and outer sheath may be provided.

In regards to claim 82, Boury discloses an endoluminal apparatus, further comprising an insufflation lumen within the main body (see Col. 8, Line 65 – Col. 9, Line 5).

In regards to claim 94, Boury discloses an endoluminal apparatus, with the second section comprising a plurality of links (see Figs. 1a-b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,916,147 to Boury in view of U.S. Patent No. 3,897,775 to Furihata.

In regards to claims 84, Boury discloses an endoluminal apparatus 10 comprising: an elongated main body 30 having a proximal end 20, a distal end 16 and at least one lumen 142 extending through the main body the main body having at least a first section 36a near the proximal end and a second section 36d near the distal end, and with the first section comprising a plurality of nested links 140 with substantially all adjacent links having mating surfaces that are in contact with but that are not connected to each other (see Fig. 7 and Col. 13, Lines 43-67), wherein the first section may be selectively switched between a substantially flexible condition and a substantially rigid condition (see Col. 6, Lines 8-19) wherein the second section is steerable relative to the first section (see Fig. 2 and Col.7, Lines 47-56); and a scope being movable through the lumen relative to the elongated main body (see Col. 2, Lines 30-43). Boury teach the more than one lumen may be provided within the main body of the apparatus (see Col. 9, Lines 1-6) but is silent with respect to a Y-port located along the first section, wherein the Y-port is in communication with at least one lumen extending through the elongated main body. Furihata teach of an analogous apparatus have a Y-Port 37 located proximally along the endoscope apparatus (see Fig. 3 and Col. 4, Lines 35-55). It would have been obvious to one skilled in the art at the time the invention was made to include a Y-port in the apparatus of Boury to enable a user to introduce additional surgical instruments at a desired site within the body as taught by Furihata.

Response to Arguments

Applicant's arguments with respect to claims 67-71, 73-80, 82-84, 92 and 94 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./
Examiner, Art Unit 3739

/Linda C Dvorak/
Supervisory Patent Examiner, Art
Unit 3739

9/29/8